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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ORRICK HERRINGTON & SUTCLIFFE LLP				NGUYEN, LUONG TRUNG
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				ART UNIT
				PAPER NUMBER
				2612

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/420,459	PRIDDY, DENNIS G.	
	<b>Examiner</b>	<b>Art Unit</b>	
	LUONG T. NGUYEN	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 January 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 January 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I invention, claims 1-16, in the reply filed on 5/12/2004 is acknowledged.
  
2. Claims 17-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/12/2004.

### ***Response to Arguments***

3. Applicant's arguments filed on 1/21/2005 have been fully considered but they are not persuasive.

In re page 14, Applicant argues that Glass neither discloses nor suggests a communications node comprising means for receiving a transmission containing a digital template comprising biometric attribute derived from an original digital image, and not a cropped or compressed version of the original digital image.

In response, regarding claim 9, it should be noted that the feature "*biometric attribute derived from an original digital image, and not a cropped or compressed version of the original digital image*" is not recited in the claim, instead, the Applicant amended claim 9 with limitation "a communications node comprising means for receiving a transmission containing a digital template associated with a remote user, said digital template comprising biometric attribute

derived from an original digital image, and means for identifying said user in response to said digital template.” The Examiner considers that claim 9 as amended still does not distinguish from Glass. Glass et al. disclose a communications node (authentication server 10, figure 2, column 4, line 45 – column 5, line 11) comprising means for receiving a transmission containing a digital template associated with a remote user (authentication server 10 receives biometric image file from client system 1, figure 2, column 4, line 45 – column 5, line 11; it is noted that the biometric image file is digitized, column 4, lines 58-65), said digital template comprising biometric attribute derived from an original digital image (biometric template, column 3, lines 45-59), and means for identifying said user in response to said digital template (matcher for verifying the identity of the user, figure 2, column 3, lines 55-59).

In re page 15, Applicant argues that there is no motivation to combine Glass and Alperovich.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, applying the teaching of Alperovich to the device of Glass allows a user to view a scene at a remote location.

In re page 16, Applicant argues that neither Musgrave nor Marwell, taken alone or in combination, discloses or suggests, among other things, the creation or utility of a multi-function integrated semiconductor device having integrated therein a personal database secure to all but a specified user, a sensor responsive to a biometric attribute, and a processor responsive to the biometric sensor and the secure personal database for verifying a sensed biometric attribute sent by the biometric sensor, and granting access to the secure personal database on biometric verification. These features, among others, are recited in claims 1 and 15, as amended.

In response, regarding claim 1, it is noted that the features "*a sensor responsive to a biometric attribute, and a processor responsive to the biometric sensor and the secure personal database for verifying a sensed biometric attribute sent by the biometric sensor, and granting access to the secure personal database on biometric verification*" are not recited in claim 1, instead, the Applicant amended claim with limitation "a multi-function integrated semiconductor device comprising a digital processing unit; a personal database secure to all but a specified user." The Examiner considers that claim 1 as amended still does not distinguish from Musgrave et al. in view of Marwell et al.. Musgrave et al. discloses a digital processing unit (processor 510, figure 8, column 13, lines 1-26). Musgrave et al. fail to specifically disclose a personal database secure to all but a specified user. However, Marwell et al. teaches this feature. Marwell et al. discloses the creating a database for storing telephone numbers in a cellular telephone is (column 1, lines 62-65, column 2, lines 13-16).

In re page 17, Applicant argues that the combination Musgrave and Maxwell is impermissible hindsight reconstruction.

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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In re page 18, Applicant argues that there is no motivation to combine Marwell, Musgrave and Alperovich.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In re page 18, Applicant argues that Marwell, Alperovich, and Ogasawara does not disclose or suggest a multi-function integrated semiconductor device incorporated within a portable wireless communications product and such device including an Internet browser and means for real-time scanning, decoding, and transmitting information encoded in an automatic identification indicia.

Regarding claims 5-8, it is noted that the feature “a multi-function integrated semiconductor device incorporated **within a portable wireless communications product** and such device including an Internet browser and means for real-time scanning, decoding, and transmitting information encoded in an automatic identification indicia” is not recited in claims 5-8.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Glass et al. (US 6,332,193).

Regarding claim 9, Glass et al. disclose a communications node (authentication server 10, figure 2, column 4, line 45 – column 5, line 11) comprising means for receiving a transmission containing a digital template associated with a remote user (authentication server 10 receives biometric image file from client system 1, figure 2, column 4, line 45 – column 5, line 11; it is noted that the biometric image file is digitized, column 4, lines 58-65), said digital template comprising biometric attribute derived from an original digital image (biometric template,

column 3, lines 45-59), and means for identifying said user in response to said digital template (matcher for verifying the identity of the user, figure 2, column 3, lines 55-59).

Regarding claim 10, Glass et al. disclose a database comprising a plurality of securely stored biometric attributes data (column 4, lines 14-18).

Regarding claim 11, Glass et al. disclose means for verifying the identity and authenticity of the user associated with a received biometric attribute template (matcher for verifying the identity of the user, figure 2, column 3, lines 55-59), wherein the transmission is associated with said user conducting a financial transaction (column 3, lines 36-42) and said transmission includes user credit or debit account information (inherently included in performing online banking transaction, column 8, lines 22-35).

Regarding claim 12, Glass et al. disclose the transmission includes data corresponding to a digital template (column 4, lines 58-60), means for storing the received digital template data corresponding to the original digital image (frame store 43, figure 3, column 5, lines 54-56).

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrave et al. (US 6,377,699) in view of Marwell et al. (US 6,668,055).

Regarding claim 1, Musgrave et al. disclose a multi-function integrated semiconductor module comprising an image sensor (video camera 105, figure 8, column 4, lines 27-31), column 6, line 61 – column 7, line 11, column 12, lines 62-67); a real-time image processing circuit (inherently included in video camera 105); a digital processing unit (processor 510, figure 8, column 13, lines 1-26); an automatic identification circuit, responsive to a captured image, to identify information coded in the image (comparing the stored images to captured image to identify if there is a match (to identify the information coded in the image), step 635, step 640, figure 10, column 13, lines 54-67); means for inputting a biometric attribute (image of an iris with its biometric attribute is inputted via lens 110 (figures 2A, 8); means for providing a wireless communication including an antenna, a transmitter, a receiver, a wireless communication protocol and an Internet browser (figures 8-9, column 13, lines 28-41); a memory containing a first biometric attribute and software for executing a predetermined application (memory 530, 532, 505, figure 8, column 13, lines 1-26).

Musgrave et al. fail to specifically disclose a personal database secure to all but a specified user. However, creating a database for storing telephone numbers in a cellular telephone is well known in the art as disclosed in Marwell et al. patent (column 1, lines 62-65, column 2, lines 13-16). Therefore, it would have been to modify the device in Musgrave et al. by the teaching of Marwell et al. in order to let the user to store personal data base such as telephone numbers. This lets the user call to any telephone numbers without the need to recall the contact's telephone numbers.

Regarding claim 2, Musgrave et al. disclose means for comparing said inputted biometric attribute to the first biometric attribute and permitting access to the secure personal database in response to the input biometric attribute matching the first biometric attribute (Musgrave et al. also disclose that when there is a match between captured image and the stored images (biometric templates), the user is able to use the phone to place a call (accessing to the database), figure 10, column 13, lines 5-13, lines 64-67).

Regarding claims 15, 16, Musgrave et al. disclose a portable wireless communications device (digital cell phone comprises imager 700 and telephone 575, figure 9, column 13, lines 37-41) comprising a multi-function integrated semiconductor device (imager 700 and telephone 575 is a multi-function integrated semiconductor device, figure 9, column 13, lines 37-41); a sensor responsive to a biometric attribute (camera 105, figure 8, column 4, lines 27-31), column 6, line 61 – column 7, line11, column 12, lines 62-67), and a processor (processor 510, figure 8) responsive to said biometric sensor and said secure personal database for verifying a sensed biometric attribute sent by said biometric sensor (figure 10, column 13, lines 54-62).

Musgrave et al. fail to specifically disclose a personal database secure to all but a specified user and granting access to said personal database on biometric verification. However, the creating a database for storing telephone numbers in a cellular telephone is well known in the art as disclosed in Marwell et al. patent (column 1, lines 62-65, column 2, lines 13-16). And Musgrave et al. also disclose that when there is a match between captured image and the stored images (biometric templates), the user is able to use the phone to place a call (accessing to the database, figure 10, column 13, lines 5-13, lines 64-67). Therefore, it would have been to

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modify the device in Musgrave et al. by the teaching of Marwell et al. in order to allow the user to call any telephone numbers without the need to recall the contact's telephone numbers.

8. Claims 3, 4, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrave et al. (US 6,377,699) in view of Marwell et al. (US 6,668,055) further in view of Alperovich et al. (US 6,317,609).

Regarding claim 3, Musgrave et al. disclose a lens (lens 110, figure 8), wherein the digital processing unit is integrated with a first memory and the image processing circuit interrogates the captured image in real-time in said memory (processor 510 is coupled to RAM 532, which stores captured image, figure 8). Musgrave et al. and Marwell et al. do not disclose an input/output means for transmitting the digital representation of captured image to a remote device. However, Alperovich et al. disclose a system and method for transporting digital speech and digital pictures, in which the digital image 355 from mobile station MS 20a is transmitted and displayed at MS 20b (figures 3-4, column 3, lines 1-10, column 6, lines 20-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Musgrave et al. and Marwell et al. by the teaching of Alperovich et al. in order to allow a user to view a scene at a remote location.

Regarding claim 4, Musgrave et al. disclose a supplementary memory (ROM 505, figure 8), a lens (lens 110, figure 8), wherein the digital processing unit is integrated with the memory, the supplementary memory, and the image processing circuit and stores the digital representation image in one of the memory and the supplemental memory (processor 510 is coupled to RAM

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532, which stores captured image, figure 8). Musgrave et al. and Marwell et al. do not disclose an input/output means for transmitting the digital representation of captured image to a remote device. However, Alperovich et al. disclose a system and method for transporting digital speech and digital pictures, in which the digital image 355 from mobile station MS 20a is transmitted and displayed at MS 20b (figures 3-4, column 3, lines 1-10, column 6, lines 20-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Musgrave et al. and Marwell et al. by the teaching of Alperovich et al. in order to allow a user to view a scene at a remote location.

As for claim 14, all the limitations are contained in claims 1 and 4. Therefore, see Examiner's comment regarding claims 1 and 4.

9. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrave et al. (US 6,377,699) in view of Marwell et al. (US 6,668,055) and Alperovich et al. (US 6,317,609) further in view of Ogasawara (US 6,512,919).

Regarding claim 5, Musgrave et al. disclose the image processing circuit further comprises means for capturing single and sequential digital images (A/D converter inherently included in video camera 105, figure 8). Alperovich et al. disclose an interface for voice/data communication channel to a networked computer server and transmitting the images (column 6, lines 60-65) including data element identifiers (code is transmitted, column 6, lines 25-35) via the interface over the communication channel to a remote location (figure 4).

Musgrave et al., Marwell et al. and Alperovich et al. do not disclose means for real-time scanning, decoding, and transmitting via the interface information encoded in an automatic identification indicia, said indicia being selected from among the group consisting of bar codes, matrix codes, Optical Character Recognition, and Radio Frequency Identification Tags; a digital processor operable to transmit queries, receive textual and graphic responses, execute secure purchase of goods or services, and remotely store records related to electronic commerce transactions, and to execute the purchase of non-electronic commerce goods and services, wherein the personal database comprises personal identification and credit card/debit card account information. However, Ogasawara discloses an electronic shopping system facilitates purchase transactions via a wireless phone, which includes a digital camera for scanning and transmitting the bar code to a server (figures 10, 13-14, column 20 - column 21), a microprocessor 238 for executing a purchase and remotely store records related to electronic commerce transactions (figure 10, column 17, lines 1-67), and customer profile information may include credit information (column 17, lines 40-47). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Musgrave et al., Marwell et al. and Alperovich et al. by the teaching of Ogasawara in order to provide the ability to conduct electronic shopping from location away from the home without the need to access his or her home television or computer (column 1, line 65 – column 2, line 5).

Regarding claim 6, Musgrave et al. disclose means for generating and transmitting a digital security coded based on an input biometric attribute and incorporating data element identifiers (extract, encrypt, and transmit template for identification, steps 370, 376, figure 6).

Regarding claim 7, Ogasawara discloses means for activating a large scale processing application on a remote server (microprocessor 238, figure 10).

Regarding claim 8, Ogasawara discloses means for securely executing personal financial transactions (shopping history information, column 17, lines 45-47).

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glass et al. (US 6,332,193) in view of Alperovich et al. (US 6,317,609).

Regarding claim 13, Glass et al. fail to specifically disclose means for downloading to a plurality of remote display devices, said stored digital template data, said remote display devices being selected from among the group consisting of portable wireless communication devices, personal computers, and cable connected television sets. However, Alperovich et al. disclose a system and method for transporting digital speech and digital pictures, in which the digital image 355 from mobile station MS 20a is transmitted and displayed at MS 20b (figures 3-4, column 3, lines 1-10, column 6, lines 20-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Glass et al. by the teaching of Alperovich et al. in order to allow a user to view a scene at a remote location.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUONG T NGUYEN whose telephone number is (571) 272 - 7315. The examiner can normally be reached on 7:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (571) 272 - 7308. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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AUNG MOE  
PRIMARY EXAMINER